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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/125,953	12/10/1998	OYSTEIN FODSTAD	7885.56USWO	8358

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EXAMINER
SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
1634	30

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/125,953	Applicant(s) FODSTAD ET AL.	
	Examiner Bradley L. Sisson	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☒ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *2,3 and 5-12*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

B. L Sisson

Bradley L. Sisson
Primary Examiner
Art Unit: 1634

Continuation of 5. does NOT place the application in condition for allowance because: At page 3 of the response received 26 July 2002, hereinafter the response, it is asserted that the Office has not provided a proper rebuttal to applicant's argument, directing attention to the Rule 116 response received 05 November 2001. It is further noted that the current response has attached thereto a Declaration under 37 CFR 1.132 by the inventor. The declaration has not been considered on the record as (1) it is unsigned and (2) it is not directed SOLELY to new issues that were raised in the last Office action. Indeed, applicant at page 3, second paragraph, of the current response states tha the examiner "has simply maintained the rejection."

At page 4 of the response applicant directs attention to page 5, starting with line 6, of the specification as disclosing the identification and study of a gene. Upon further review of page 5, starting at line 6, it is noted that the specification discusses possible experiments that could be conducted. It is noted that the specification directs one to work reported by Liang and Pardee (Science, Vol. 257, pages 967-971, 1992) as disclosing differential display cloning procedure. This showing and teaching by the specification has not been found to be sufficient to overcome the issue of non-enablement, as the specification does not set forth the reaction conditions disclosed in the non-patent publication, nor does the specification incorporate by reference said publication. Accordingly, the passage to which applicant has directed attention is considered at best to only provide motivation and possibly point future artisans in a direction of future endeavors. This passage does not, as applicant asserts, teach the identification and study of any gene with such full and complete terms that the public is put in possession of the method.
At page 5 of the response applicant directs attention to the publication of Liang and Pardee as "prior art teachings that would fully enable the claimed method of claim 9. As noted in the prior Office actions and reiterated herein, the documents that are referenced by the disclosure have not been incorporated by reference. Accordingly, cited publications cannot be relied on for enablement purposes nor can any passage found therein be brought into the present disclosure.

At page 4-5 of the response received 05 November 2001 applicant directs attention to the recited steps found in claim 12 and to page 4 o the subject specification where foreign patent publications (WO 94/07139 and PCT/NO/95/00052) have been identified. Said page 5, second paragraph, also asserts that "[m]any techniques such as reverse transcriptase PCR (RT PCR), RNAse protection assays, and Northern blots, differential display and subtractive hybridization were available to the skilled artisan." Applicant asserts further that the specification was therefore enabling.
The above argument has been fully considered and has not been found persuasive for as indicated above, the specification has not incorporated by reference the cited documents nor has the specification directed attention to the pertinent portion(s) of the documents. Accordingly, these prior art publications cannot be relied upon by applicant for enabling the presently claimed invention. While agreemen is reached in that some prior art methods may have been known in the art, the specification must teach in such full and complete term an requisite clarity just how these prior art methods are to be adapted so the allow for the full practice of the now-claimed, and admitted non-obvious method.

For the above reasons, and in the absence of convincing evidence to the contrary, the rejection of claims 2, 3, 5-9, and 12 under 35 USC 112, first paragraph is maintained.